

### **REMARKS**

This response is being filed in response to the Notice of Non-Compliant Amendment (37 CFR 1.121) dated February 04, 2008. The notice of Non-Compliant Amendment indicated that the amendment accompanying the request for continued examination filed on December 12, 2007 did not include the claim amendments previously included in the filed response of September 11, 2007.

To this end, Applicants have amended claims 28, 39, and 47-50 to correctly reflect the current status of the claim language thereby correcting the defects noted in the Notice of Non-Compliant Amendment of February 4, 2008. The Applicants resubmit below the remarks section submitted with the amendment of December 12, 2007.

Claims 1-52 are pending. Claims 28-52 stand rejected. Claims 28, 39, and 47-50 have been amended to clearly recite “[a] computer program product, fixed in a computer readable storage medium”. No claims have been canceled, and claims 53-58 have been added as new. Support for claims 53-58, reciting, in relevant part, “a computer program product [fixed in a computer readable storage medium], wherein the computer readable storage medium is removable,” is found at page 12 lines 15-16 of the Application. Therefore, claims 1-58 are pending. Applicants respectfully request reconsideration of the claims in view of the above amendments and the following remarks.

### **35 U.S.C. § 101**

Claims 28-52 have been rejected under 35 USC Sec. 101 as claiming non-statutory subject matter.

(1) The amended claims 28-52, reciting a “computer program product, fixed in a computer readable storage medium, for use with a computer system” remain unambiguously statutory, according to MPEP rules. MPEP §2106.01 (I) clearly directs that, when computer programs are recited as part of a claim,

“USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. IN SUCH A CASE, THE CLAIM REMAINS STATUTORY IRRESPECTIVE OF THE FACT THAT A COMPUTER PROGRAM IS INCLUDED IN THE CLAIM.”

MPEP Sec. 2106.01(I) buttresses this conclusion even further by stating that there exists *only one* situation when the computer program product claims will be viewed as non-statutory:

“[o]nly when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence non-statutory.”

Claims 28-52, as amended, are not directed to a mere program listing. The subject matter claimed in these claims is decidedly statutory.

(2) In addition, the Final Office Action dated September 20, 2007 takes the words of the Application out of context when it defines the claimed computer program *to be* a signal based on line 12 on page 12 of the specification (pg. 2, para. 3 and pg. 3, para. 6 of Final Office Action). Taking the words out of the context is contrary to the rules. See MPEP §2106.01 (“IN THE FINAL ANALYSIS UNDER §101, THE CLAIMED INVENTION, AS A WHOLE, MUST BE EVALUATED FOR WHAT IT IS.”) (internal quotation omitted ) (emphasis added).

The Examiner’s position of a computer program being a signal is *not* supported factually. The Application does *not* define the computer program product *to be* a signal. Instead, the Application names a signal to be a representation of one of the forms in which the claimed computer program may be transmitted to a computer (Application, pg. 12, ll. 11-12). At the same time, the Examiner oversees that “[t]he computer program may be fixed in any form ... in a tangible storage medium, such as a semiconductor memory device” (pg. 12, ll. 6-8) or “may be distributed in any form as a removable storage medium” (pg. 12, ll. 15-16).

The Court of Appeals for the Federal Circuit has ruled that a semiconductor memory device and a removable storage medium both possess physical form and, therefore, fall into a statutory category of patentable articles of manufacture. *See, e.g.*,

*Bayer AG v. Housey Pharms., Inc.*, 340 F.3d 1367, 1373 (Fed. Cir. 2003). The computer product claims as amended herewith are drawn to a computer program product, that is fixed in a readable storage medium, for use with a computer system and, therefore, these claims are indisputably statutory under *In re Beauregard* and its progeny. *In re Beauregard*, 53 F. 3d 1583, 1583-84 (Fed. Cir. 1995) (noting Patent Office's finding that "computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101."); *USPTO Examination Guidelines for Computer-Related Inventions*, 61 Fed. Reg. 7478, 7482 (1996) ( "[A] claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory.")

### CONCLUSION

All pending claims are believed to be in a form suitable for allowance. The Applicants respectfully request early allowance of the application. The Applicants also request that the Examiner contact the undersigned, John J. Stickevers, if it will assist further examination of this application. Applicants do not believe any extension of time is required for timely consideration of this response. In the event that an extension has been overlooked, this conditional petition of extension is hereby submitted, and Applicants request that deposit account number 19-4972 be charged for any fees that may be required for the timely consideration of this application.

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Respectfully submitted,

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